

REMARKS

The last Office Action dated December 20, 2004 has been carefully considered.

It is noted that **Claims 1-6** have been canceled and **Claims 7-9** have been added.

It is noted that **Claims 1-6** are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is believed that the above amendments to the claims are fully responsive to the Examiner's rejection, in that Claims 1-6 have been canceled and **Claims 7-9** are drawn to the subcombination of the gauge mounting device.

It is noted that **Claims 1-6** are rejected under 35 U.S.C. § 112, first paragraph, as the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention. It is believed that the above amendments to the claims are fully responsive to the Examiner's rejection.

It is noted that Claims 1, 2, 3, and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Nelson et al.** (U.S. Pat. No. 6,244,107) in view of **Kaysing** (U.S. Pat. No. 2,187,880).

It is further noted that Claims 4 and 5 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Nelson et al.** (U.S. Pat. No. 6,244,107) in view of **Kaysing** (U.S. Pat. No. 2,187,880 and in view of **Hawang** (U.S. Pat. No. 5,681,058)

Applicant believes that **Nelson et al.** teaches a much more complex invention than the invention of the present application, by focusing on complex embodiments of snap together elements that require annular and parallel ribs on the gauge housing for attachment with the gauge bracket having ratcheting surfaces. Thus, applicant believes that **Nelson et al** teaches away from the simplicity of the present invention, which

provides a solution to the problem of the ergonomically difficulties of the prior art with a minimum of manufacturing steps. See *In re Baird*, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994) (prior art reference “appears to teach away from the selection of” the claimed composition “by focusing on more complex examples”). The fact that a simple solution has escaped other workers in the art is some evidence that it was **not obvious** to a person of ordinary skill in the art. See *In re Shelby*, 311 F.2d 807, 810, 136 USPQ 220 (CCPA 1963):

Appellant’s claimed invention departs from the prior art in the direction of simplicity rather than in the direction of complexity. . . . The simplicity of this useful invention is, in retrospect, some evidence that it was not obvious to a person of ordinary skill in the art In re Osplack, 39 CCPA 932, 195 F.2d 921, 93 USPQ 306. . . . While it is admittedly simple, it has escaped the other workers in this crowded art. We do not think the simplicity of appellant’s construction should deprive him of his right to a patent thereon. Expanded Metal Co. v. Bradford, 214 U.S. 366.

It is noted that the present application provides a gauge mounting device with application to any standard gauge housing without the necessity of additional manufacturing steps relative to the gauge housing. The present invention does not require the gauge housing to have annular and parallel ribs requiring additional manufacturing and can be used with any standard gauge housing. Also, the present invention does not include flexible tabs on the gauge bracket which are disposed on annular and parallel ribs.

Applicant believes, therefore that **Nelson et al.** teaches away from using a

gripper ring of the **Kaysing** invention, and also teaches away from combining any other reference having a disclosure of a gripper ring. (**Hawang**) A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. *See Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

The **Nelson et al.** patent is cited as disclosing snap together elements eliminating the need for screwing the bracket onto the housing for attachment. (col. 1 lines 39, 40). Furthermore, the **Nelson et al.** patent discloses flexible tabs extending from the bracket for retention on the housing. (col. 2 lines 23-30). Therefore it is respectfully submitted that combining the references discussed above would not lead to the claimed invention. It is further believed by the Applicant that taken in combination the cited references would produce a seemingly inoperative device as **Nelson et al.** discloses the ratcheting surfaces are contemplated to form buttress threads for ratcheting the bracket onto the housing. (col 2 lines 20-25). It would seem inoperative if a gripper ring is introduced as suggested that the snap together elements disclosed in **Nelson et al.** would be inoperable.

It is respectfully submitted that the new **claims 7-9** clearly and patentably distinguish over the prior art, since it is believed that the construction defined in these claims differs essentially and in an unobvious, highly advantageous manner from the constructions disclosed in the references.

As for the proposed combination of references cited by the examiner, it is respectfully submitted that since none of the references in the combination teaches the distinctive features of applicant's invention as defined now in the new **claims 7-9**, any hypothetical construction produced by this combination would not lead to applicant's

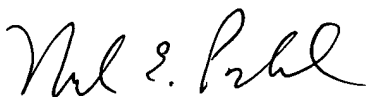
invention and seemingly would produce an inoperative device.

It is respectfully submitted that the combined teachings of the references applied by the Examiner fail to disclose or even suggest the subject matter of the claims at issue. That a prior art reference could be modified to form the claimed structure does not supply a suggestion to do so. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

In view of these considerations, it is respectfully submitted that the rejection of the original claims should be considered as no longer tenable with respect to the new claims 7-9 and should be withdrawn. The new **claims 7-9** should be considered as patentably distinguishing over the art and should be allowed.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned.

Respectfully submitted:

A handwritten signature in cursive script, reading "Mark E. Pochal", is written over a horizontal line.

Mark E. Pochal (Reg. #: 35,982)
86 Denison Avenue
Mystic, CT 06355
860-536-1632